REMARKS / ARGUMENTS

The present application includes pending claims 1-64, all of which have been rejected. Claims 1, 6, 20 and 39 have been amended to further clarify the language used in these claims and to further prosecution of the present application. The Applicant points out that the amendments to the claims may find support in, for example, paragraph 0046 and in Fig. 1 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-6, 8, 10-14, 17-18, 20-21, and 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2004/0139180, ("White").

Claims 7, 9, 15-16, 19, 22-24, and 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over White as applied to claims 1-6, 8, 10-14, 17-18, 20-21, and 25-26 above, and further in view of USP 6,845,398 ("Galensky").

The Applicant respectfully traverses these rejections at least based on the following remarks.

I.   Examiner's Response to Arguments

At page 19 of the Office Action, the Examiner argues that Applicant's claim 1 does not specify how "specific ones of the media files" are selected for accessing and downloading. The Examiner also argues that "even if White synchronizes all media files, or a random set of media files, it can be said that specific media files were

synchronized, where the specific media files that were synchronized are all of the media files". In other words, the Examiner seems to argue that Applicant's "specific ones of the media files" can be **any random media files, up to all** the media files.

The Applicant respectfully disagrees and refers the Examiner to Webster's New College Dictionary, third edition, which defines the term "specific" as "distinctive, definite". Also, Webster defines the term "any" as "selected from **random without restriction or exception** of the whole". In other words, the term "specific" is definite and restrictive, which is opposite to "random without restriction". Likewise, if **all** the media files are selected, there is no further need of selection for specific media files. Therefore, the Examiner's argument that White's disclosure of synchronizing the entire media files, or any of the media files reads on Applicant's "specific ones of the media files" is incorrect and in fact, contrary to Applicant's claim 1.

Nevertheless, for the sake of advancing prosecution, the Applicant has amended claim 1 to further clarify the claim language, which now reads "wherein **the media files are stored in one or more directories of the server based on particular locations of the at least one client**, and **only <u>specific ones </u>of the media files are accessed <u>from a particular one or more of the server directories</u>, and downloaded by the at least one client <u>based on the particular location of the at least one client</u>**". The Applicant points out that the above amendments clarify that "**the specific ones** of the media files" are selected **<u>from a particular one or more of the server directories, and based on the <u>particular location of the at least one client</u>**. Applicant's claim 1

thus further distinguishes from White's teaching of synchronizing and downloading **all** the available media files (*see* White at the abstract) stored in the media server 110 without associating to any specific locations (i.e., media files has no association to particular location).

Based on the above rationale, the Applicant submits that White does not suggest or disclose "accessing and downloading the media files ... wherein the media files are stored in one or more directories of the server based on particular locations of the at least one client, and only specific ones of the media files are accessed from a particular one or more of the server directories, and downloaded by the at least one client based on the particular location of the at least one client," as recited in Applicant's claim 1. Claim 1 is therefore submitted to be allowable, and the Applicant respectfully requests that the rejection to claim 1 under 35 U.S.C. 103(a) be withdrawn.

With regard to the rejection of claim 6, the Examiner disagrees with the Applicant's argument that White's disclosure of downloading and decoding the "entire media file" is in fact logically opposite to Applicant's "portions of a media file". The Examiner at page 20 of the Office Action maintains the rejection, and specifically requests Applicant to provided support to the argument that the term "entire" is logically opposite in meaning to the term "portion of".

The Applicant again refers the Examiner to Webster's New College Dictionary, third edition, which defines the term "portion" as "**a part separated from a whole**" (i.e.,

less than 100%), which is logically opposite to the meaning of the term "entire" as "having **no part left out**, **complete**" (i.e., 100%). Based on the foregoing rationale, the Applicant maintains that White teaches away from Applicant's claim 6. Therefore, claim 6 should be allowable.

Furthermore, with regard to rejection of claim 26, in page 20 of the Office Action, the Examiner disputes Applicant's traversal arguments to Examiner's "Official Notice". The Applicant has provided reasons of traversal. Specifically, Applicant argues that "White's (non specific) two way synchronization and downloading to produce **identical media files** in both servers, stipulates the necessity of a successful and **impartial transfer of all the media files between the two servers**. Based on this rationale, White's two-way synchronization would not have taken place if there is a lack of memory space in the mobile server 130 in the car". The Examiner argues that White would have suggested that the user could erase the files (manually) to allow more memories for downloading. The Examiner also emphasized that Applicant does not specify such requirement be done automatically.

The Applicant respectfully disagrees, and points out that claim 26 clearly recites "**automatically** accessing ..., comparing...,downloading ..., removing...if the memory in the care does not have sufficient storage space for more files." In other words, the Applicant in claim 26, does clearly specify that such requirement is done automatically. The Applicant therefore maintains that claim 26 is allowable.

With regard to rejection of claim 29, in page 21 of the Office Action, the Examiner alleges that Applicant's traversal arguments to Examiner's "Official Notice" was inadequate without pointing out Examiner's supposed errors. The Applicant respectfully disagrees. Specifically, the Applicant argued in pages 25-26 of the 11/6/08 response, that White's "synchronizing the mobile media server with a set of media ...simply have the set of media being **all the media** in a specific directory," which clearly implies that **all the media files between the mobile server 130 and the home media server 110 will be synchronized and copied without any exception**. In this regard, White does not suggest or disclose Applicant's "the **specific ones of the media files** are accessed and downloaded **from a specified directory on the server** ...," as recited in claim 29.

The Examiner in page 29 of the Office Action takes Official Notice, and further suggests that White could be modified to have "specific ones of the media files" be accessed and downloaded from a specified directory on the server. The Examiner specifically suggested two ways to implement such modification in White, namely, by storing media files locations in a table, or by having all the media in a specific directory.

The Applicant points out that the Examiner's suggestions are reconstructed based on improper hindsight reasoning (*see* MPEP §2145 X-A). To substantiate Applicant's argument, White does not disclose or suggest that the media files be stored into specific directories associated with the particular location of the client on the server. As pointed out in the Applicant's above argument to claim 1, White discloses using a home media server 110 to store the media files **in a home location**. White at best

discloses or suggests that the media files be stored in only a general home location for media files synchronization, **White does not differentiate that the stored media files are based on the particular locations of the mobile server 130, let alone suggesting storing specific ones of the media files in directories based on particular locations of the mobile media server 130, when the mobile media server 130 moves to another location of the home within the range of the hub 120.** In this regard, the Applicant maintains that the Examiner's Official Notice rejects Applicant's claim based on hindsight and claim 29 should be allowable.

The Examiner has rejected Applicant's other claims of similar features based on repeating certain Official Notice arguments. The Applicant maintains that the traversal arguments to Official Notice in claims 1, 6, 26 and 29 are applicable to all the affected pending independent and/or dependent claims.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II.   White Does Not Render Claims 1-6, 8, 10-14, 17-18, 20-21, 25-26, 39-44, 46, 48-52 and 55-64 Unpatentable

The Applicant first turns to the rejection of claims 1-6, 8, 10-14, 17-18, 20-21, 25-26, 39-44, 46, 48-52 and 55-64 as being unpatentable over White.

A.   Independent Claims 1, 20 and 39

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that White does not disclose or suggest at least the limitation of "accessing and

downloading the media files ... wherein **the media files are stored in one or more**

directories of the server based on particular locations of the at least one client,

and **only specific ones of the media files are accessed from a particular one or**

more of the server directories, and downloaded by the at least one client **based on**

the particular location of the at least one client," as recited in Applicant's

independent claim 1. The Office Action states the following:

> "With regard to claim 1, White discloses a system for wirelessly playing
> media files, the system comprising:
>
> a central server having a memory for storing the media files (White:
> Figure 2, 110); a station connected to the central server (White: Figure 2,
> 120);at least one client, the client capable of accessing and downloading
> the files by wirelessly communicating with the server via the station from
> a plurality of remote locations from the station and the server (White:
> Figure 2, 130 and Paragraph [0014]. The mobile media server (130) is
> capable of accessing and downloading the files through the wireless hub
> anywhere within range of the wireless hub. As the mobile media server
> can be anywhere within range of the hub, this constitutes a plurality of
> locations.), wherein only specific ones of the media files are accessed
> and downloaded by the at least one client based on a particular location
> of the at least one, client (White: Abstract. The media files are only
> downloaded when the client is in range of the server, meaning that the
> access and download is based on a particular location).
>
> White does not disclose expressly a plurality of devices capable of
> outputting the specific ones of the media files, wherein the at least one
> client operably connects to the devices. However, **Examiner takes**
> **Official Notice (See MPEP §2144.03) that this functionality was well**
> **known by a person of ordinary skill in the art**."

See Office Action at pages 2-3. The Examiner relies on Official Notice to reject

Applicant's claim 1. The Applicant maintains the arguments in the 11/6/08 response.

Namely, even though White discloses that the mobile media server 130 can access and

download files through the wireless hub 120 within range of the wireless hub 120, **White still does not differentiate that the stored media files are based on the particular locations of the mobile server 130, let alone storing specific ones of the media files in directories based on particular locations of the mobile media server 130, when the mobile media server 130 moves to another location of the home within the range of the hub 120.**

On the contrary, White in the Abstract discloses clearly a two way synchronization, which automatically provides "**the same media on both the home media server** 110 **and the mobile media serve**r 130", which is non-specific. In other words, White does not disclose any restriction for the accessibility of the available media files for downloading. Furthermore, the Examiner is referred to Applicant's arguments in section I above. Namely, the Examiner's argument that White's disclosure of synchronizing the entire media files, or any of the media files reads on Applicant's "specific ones of the media files", is incorrect and, in fact, contrary to Applicant's claim 1.

Based on the foregoing rationale, the Applicant maintains that White does not disclose or suggest "accessing and downloading the media files ... wherein **the media files are stored in one or more directories of the server based on particular locations of the at least one client**, and **only specific ones of the media files are accessed from a particular one or more of the server directories**, and downloaded by the at least one client **based on the particular location of the at least one client**," as recited in Applicant's independent claim 1.

The Applicant submits that claim 1 is allowable. Independent claims 20 and 39 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 20 and 39 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B.   Rejection of Dependent Claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 20 and 39 under 35 U.S.C. § 103(a) as being unpatentable over White has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64 depend from independent claims 1, 20 and 39, respectively, and are, consequently, also respectfully submitted to be allowable.

Regarding the rejection of claim 6, the Applicant maintains the arguments in the 11/6/08 response. The Examiner is further referred to Applicant's above arguments in section I, namely, White's disclosure or downloading and decoding "entire" media file is, in fact, logically opposite to Applicant's claimed "portions of a media file".

Therefore, based on the foregoing rationale, the Applicant maintains that White does not disclose or suggest "downloading and decoding **portions of the** specific ones **of the** media files," as recited in claim 6 by the Applicant.

Claim 21 is rejected for the same rationale as claim 6 by the Examiner, and is submitted to be allowable for the same rationale as discussed with respect to claim 6.

Regarding the rejection of claim 26, the Examiner is referred to the arguments in the 11/6/08 response. The Examiner is further referred to Applicant's above arguments in section I, namely, White's two-way synchronization would not have taken place if there is a lack of memory space in the mobile server 130 in the car. The Examiner argues that White would have suggested that the user could erase the files (manually) to allow more memories for downloading. However, Applicant's claim 26 clearly recites "**automatically** accessing ..., comparing..., downloading ..., removing...if the memory in the care does not have sufficient storage space for more files." In other words, Applicant's claim 26 clearly specifies that such requirement is done automatically. Claim 26 is therefore allowable.

Regarding the rejection of claim 29, the Examiner is referred to the arguments in the 11/6/08 response. The Examiner is further referred to Applicant's above arguments in section I, namely, White's "synchronizing the mobile media server with a set of media ...simply have the set of media being **all the media** in a specific directory," clearly implies that **all the media files between the mobile server 130 and the home media server 110 will be synchronized and copied without any exception**. In this regard, White does not suggest or disclose Applicant's "the **specific ones of the media files** are accessed and downloaded **from a specified directory on the server** ...," as recited in claim 29.

The Examiner, in page 29 of the Office Action, specifically suggested two ways to implement such modification in White, namely, by storing media files locations in a table, or by having all the media in a specific directory. The Applicant points out that the Examiner's suggestions are reconstructed based on improper hindsight reasoning (*see* MPEP §2145 X-A). **White does not differentiate that the stored media files are based on the particular locations of the mobile server 130, let alone storing specific ones of the media files in directories based on particular locations of the mobile media server 130, when the mobile media server 130 moves to another location.**

Based on the above rationale, White at best discloses or suggests that the media files be stored in only a general home location for media files synchronization. In this regard, the Applicant maintains that the Examiner's Official Notice rejects Applicant's claim based on hindsight. Therefore, the Applicant maintains that claim 29 should be allowable.

Regarding the rejection of claim 33, the same rationale as claim 29 applies, namely, White does not differentiate that the stored media files are based on the particular locations of the mobile server 130, let alone storing specific ones of the media files **in directories based on particular locations of the mobile media server 130**. When the mobile media server 130 moves to another location, White does not disclose that the mobile media server 130 only access or download the directories based on the new location. Likewise, as argued in claim 29, the Examiner's suggestion that White

could be modified to store a media file table or in a specific directory based on particular location, is a reconstruction based on hindsight. Claim 33 is submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64.

III. The Proposed Combination of White and Galensky Does Not Render Claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 20 and 39 under 35 U.S.C. § 103(a) as being unpatentable over White has been overcome and requests that the rejection be withdrawn. Additionally, the additional cited reference (Galensky) does not overcome the deficiencies of White in independent claims 1, 20 and 39. Claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54 depend from independent claims 1, 20 and 39, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54.

In general, the Office Action makes various statements regarding claims 1-64 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly

reserves the right to challenge such statements in the future should the need arise (e.g.,

if such statement should become relevant by appearing in a rejection of any current or

future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-64 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: April 13, 2009   / Frankie W. Wong /

                                      Frankie W. Wong
                                      Registration No. 61,832
                                      Patent Agent for Applicant

MCANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8093 (FWW)
Facsimile: (312) 775 – 8093